

The Amendments

Claim 10 has been canceled without prejudice and without intent to abandon the subject matter claimed therein. Applicants reserve the right to pursue the subject matter of claim 10 in another application.

New claims 40-52 have been submitted to delineate the nature of the currently claimed invention. Support for the new claims can be found completely within the specification as follows:

- **An antisense polynucleotide:** is defined in the specification at page 78, line 26 through page 79, line 12.
- **the polynucleotide is capable of specifically hybridizing to the genome of a hepatitis C virus:** page 78, line 26-29.
- **the polynucleotide comprises a contiguous sequence of at least 8 (or 10, 12, 15 or 20) nucleotides complementary to the genome of an HCV:** page 26, line 17 through page 27, line 15.

Additional support for claims 46-52 can be found at pages 77-79 of the specification, and also at page 28, lines 19-31. No new matter has been added by these amendments.

This application was subject to a restriction requirement issued in the parent '273 application on January 10, 1995 (Paper No. 3), and Group II was elected herein. New claims 40-52 herein do not correspond exactly to any of the claims originally grouped by the Examiner as Groups I-VIII. Applicants submit that the current amendment is nevertheless properly entered under the transitional procedures of 37 C.F.R. §1.129(a).

The Examiner's attention is also drawn to four related co-pending cases: U.S. Serial Nos. 08/040,564 ("the '564 application"), 08/307,273 ("the '273 application"), 08/440,769 ("the '769 application"), and 08/472,821 ("the '821 application"). The claims in the '564 and '273 applications are directed to oligonucleotide probes for detecting HCV. A Notice of Allowability was issued in the '564 application on August 27, 1996, and the issue fee has been paid. The claims in the '769 and '821 applications are directed to methods for detecting an HCV sequence using oligonucleotide probes, and are drawn to a separately patentable invention from the other two cases pursuant to a restriction requirement issued in U.S. Serial No. 07/566,209 (the parent

of the '564 application and grandparent of the '769 application) on June 12, 1991. A Notice of Allowability was issued in the '769 application on August 22, 1996, and the issue fee has been paid.

The Provisional Double Patenting Rejection

Claim 10 stands provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claim 10 of copending U.S. Serial No. 08/440,755. This rejection is believed to be overcome by the above amendments. Accordingly, applicants respectfully request reconsideration and withdrawal of this provisional rejection.

The Rejection Under 35 U.S.C. §112, First Paragraph

Claim 10 stands finally rejected under 35 U.S.C. §112, first paragraph, as the Examiner states that the claimed invention is not described in the specification in such a way as to enable any person skilled in the art to make and use the same. This rejection is believed to be overcome by the above amendments. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

The Rejection under 35 U.S.C. § 102

Claim 10 stands finally rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Prince et al., *The Lancet*, 10 November 1984, pp. 1071–1075. Similarly, claim 10 was rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by two Seto et al. references (U.S. Patent Nos. 4,673,634 and 4,707,439), Coursaget (U.S. Patent No. 4,464,474), and Wands (U.S. Patent No. 4,870,026). This rejection is believed to be overcome by the above amendments. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102.

Conclusion

Applicants submit that the pending claims do not now constitute double patenting, are not anticipated under 35 U.S.C. §102, and comport with the requirements of 35 U.S.C. §112, first

PATENT
Atty. Docket No. 0063.024

paragraph. Accordingly, applicants believe that a withdrawal of finality and issuance of a notice of allowance are in order, and are respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,

Dated: 18 September 1997

By:

Kenneth M. Goldman

Kenneth M. Goldman
Reg. No. 34,174

CHIRON CORPORATION
Intellectual Property - R440
P.O. Box 8097
Emeryville, CA 94662-8097
(510) 923-2719